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| 10/620,269      | 07/15/2003  | Sandeep Bhatt        | 02077(3600-395-01)  | 8766             |

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| EXAMINER |
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HENDRICKSON, STUART L

| ART UNIT | PAPER NUMBER |
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1754

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/620,269

Applicant(s)

BHATT, SANDEEP

Examiner

Stuart Hendrickson

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 and 24-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 24-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 4, 5, 7-11, 26, 28-30, 34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Van Konynenburg et al. 4775778.

The reference teaches in col. 6 and 13 black Regal 660 having area of 112 and size of 17 nm. Column 6 teaches the overall particle size (325 mesh is 44 micron, so the teaching of 80 nm meets the 325 mesh limitation). The reference does not explicitly teach the claimed iodine number, however the iodine and nitrogen values roughly correspond. Therefore, it appears that the product is the same. A polymer composition having 5-50% carbon black is taught; see col. 8, 15. The ash and sulfur values appear within the range of conventional carbon blacks. Where the examiner has found substantially the same product as claimed in the art, the burden is upon the applicant to show a difference; In re Fitzgerald et al. 205 USPQ 594.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Konynenburg. The reference does not teach the kind of polyethylene, however teaches the genus. Using the claimed type of PE is an obvious expedient because it meets the requirements of the polymer needed.

Claims 1-21, 24-30, 34-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Sant 5877250.

The reference teaches what appears to be the claimed carbon black. Specification pg. 13 indicates that the present carbon black is the same as that of Sant, with no modifications made.

Claims 1-21, 24-30, 34-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Sant 5877251.

The reference teaches what appears to be the claimed carbon black. Specification pg. 13 indicates that the present carbon black is the same as that of Sant, with no modifications made.

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Claims 1, 4, 7-9, 25, 26, 29, 30 and 34-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Thielen 5902517 in view of Probst et al. 5639817.

The reference teaches in table 1 ENASCO 250 carbon black having area 65 and low volatiles content (which appears to meet the toluene extractables claimed since both represent low weight organic compounds). Column 1 indicates low primary particle size and a resin is taught (col. 2 line 30). Probst table 2 teaches iodine of 47 ('about 50'), DBP 160, CDBP of 92, and teaches rubber composition. The 325 mesh appears met since carbon black as synthesized is a fine powder and the ash, sulfur values appear conventional.

Where the examiner has found substantially the same product as claimed in the art, the burden is upon the applicant to show a difference; In re Fitzgerald et al. 205 USPQ 594.

Claims 1-21, 26-30, 34-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22-53 of U.S. Patent No. 6852790.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim common, overlapping, subject matter in the ranges of values.

The reference elucidates in col. 3 overlapping particle size, and other properties. The polymers are indicated in col. 8.

Claims 1-10, 26, 29-33 and 41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6482386.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the numerical values overlap.

Column 4 teaches a tube shape and fluffy form, which indicates the 325 mesh limitation is met.

The Industrial Carbon reference is presented as evidence that as-synthesized carbon blacks meet the 325 mesh limitation.

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Claims 1-9, 11-17, 19-21, 24-26, 28-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamazaki et al. 6025429 in view of Weaver et al. 5352289, Dickerson 4755371 and Industrial Carbon.

Yamazaki teaches in the entire document, especially ex. 6 and col. 11, examples of acetylene blacks having low ash and grit contents, and iodine values of 92 and 110. Col. 1 teaches polymers and col. 3 teaches the loading. This does not explicitly teach all the claimed properties, however Weaver teaches in col. 3 that acetylene blacks are known to be low in ash and S, which is expected because they are made from a source which contains little or no S or metals. Note also the DBP values recited. Dickerson teaches in column 6 the claimed 325 mesh residue for carbon black. The Industrial Carbon reference is presented as evidence that as-synthesized carbon blacks meet the 325 mesh limitation. Therefore, it appears based upon this additional evidence that the carbon black of Yamazaki renders the claims unpatentable.

Concerning the pressure pipe and other compositional features, these are deemed intended use which does not limit the product.

Applicant's arguments filed 7/20/06 have been fully considered but they are not persuasive. Concerning '778, the iodine and nitrogen are shown to correlate by the Dee Snell article pg. 186 submitted. While it is true they do not absolutely correspond, the burden is upon the applicant to show a difference; the Office does not have the facilities to do so. Also, the references of record indicate that the sulfur values claimed are conventional- note the references which recite S content. Concerning the ASTM procedures, or lack thereof, it appears prima-facie that the reference meets the claims; it is not clear why the values reported would not be accurate irrespective of what procedure was used. Further, the claims do not require any particular ASTM methodology. Concerning CDBP, it is less than DBP. The DBP of the reference is 54 so the CDBP will be less than 54 and therefore less than 102. Applicant should fully characterize the

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Sant products because it appears from the description that they are indistinct from what is claimed.

Concerning Thielen, a multiple reference 102 is proper- see MPEP 2131.01. The applicant cannot on one hand argue that the examiner has shown no evidence that a certain property is possessed yet on the other hand argue that it is improper to have references to show the property. Applicant should show a difference.

Concerning the ODP rejections, it is permissible to point to the specification to show properties which are part of the product.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (571) 272-1351.



Stuart Hendrickson  
examiner Art Unit 1754